

REMARKS¹

Applicants file concurrently herewith a Request for Continued Examination (RCE) in response to the Final Office Action (the "Office Action") mailed April 10, 2006. In the outstanding Office Action, the Examiner rejected claims 1-3, 7-13, 17-23, and 27-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,018,718 issued to Walker et al. (hereinafter, "Walker"); and rejected claim 4-6, 14-16, and 24-26 under 35 U.S.C. § 103(a) as being unpatentable over Walker.

By this amendment, Applicants have amended claims 1, 11, and 21; canceled claims 2-4, 12-14, and 22-24; and added claims 31-36. Support for the amendments can be found at, for example, paragraphs 27, 33-34, and 36-38 of Applicants' specification. No new matter has been added. Accordingly, claims 1, 5-11, 15-21, and 25-36 remain pending.

In light of the foregoing amendments and based on the arguments presented below, Applicants respectfully traverse the rejections of the claims under 35 U.S.C. §§ 102(b) and 103(a), and request allowance of pending claims 1, 5-11, 15-21, and 25-36.

I. Interview Summary

Applicants acknowledges with appreciation the interview granted to Applicants' representatives on August 8, 2006 and the courtesies extended by the Examiner during the interview. At the interview, the primary issues discussed were the (1) interpretation

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

of the terms “points” and “consumer goods” in view of the cited reference and (2) features related to the adjustment of reward points associated with a financial account.

Applicants’ representatives presented arguments regarding the terms “points” and “consumer goods,” as used in Applicants’ claims. However, no agreement was reached between the Examiner and Applicants’ representatives on this issue.

In addition, Applicants’ representatives explained the differences between the cited art and the claimed features related to adjusting the amount of reward points. Consistent with the discussion, Applicants have canceled claims 2-4, 12-14 and 22-24 and included the language of dependent claims 3, 4, 13, 14, 23, and 24 into the independent claims 1, 11, and 21. Applicants have also amended the independent claims to more accurately reflect the reduction of the associated points. The Examiner tentatively agreed that Walker does not teach or suggest the elements proposed during the interview and included in this amendment, but indicated that such an amendment would require further search and consideration.

II. Claim Rejections Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-3, 7-13, 17-23, and 27-30 under 35 U.S.C. § 102(b) as being anticipated by Walker. A proper anticipation rejection requires each and every element set forth in the claim be found, either expressly or inherently described, in a single prior art reference. See MPEP § 2131. The anticipation rejection set forth in the Office Action does not properly establish that each and every claimed element of the rejected claims is found in Walker.

Walker discloses a “method ... for providing and managing a customized reward offer to a holder of a financial account ... includ[ing] the step[s] of determining a first

performance target associated with the financial account ... selecting a reward offer having an associated reward description and transmitting the first performance target and the reward description to the account holder.” Walker, column 3, lines 16-25. Walker further teaches a “performance target and corresponding reward offered to a particular card holder account.” *Id.* at column 5, lines 63-64. Walker states “[t]he type of performance target applicable to a card holder account is generally selected from a set of target types defined by the credit card issuer” and discloses examples of performance targets, such as, target quarterly charge volume, target quarterly outstanding balance, target number of transactions per month, target monthly principle payments, target annual purchases at specific merchants, and target balance transfer amounts. *Id.* at column 6, lines 19-29. Walker further discloses a “reward terms element ... to provide rewards to a credit card account in the event the performance target has been achieved.” *Id.* at column 6, lines 48-52. The Office Action asserts that “Walker et al. discloses that the reward incentives may comprises numerous reward types such as frequent flyer points.” Office Action, page 16.

The Office Action further asserts that “Walker discloses ... wherein determining an amount of reward points further comprises: reducing an amount of reward points based on a determination that an amount of the received payment is below the minimum payment amount.” Office Action, pages 3 and 8 (referring to claims 3 and 23); See *a/so* Office Action, page 6 (referring to claim 13). However, that is not correct. Walker teaches “[i] the card holder performance value is less than or equal to the 90% of the first 416, CCI 200 determines the second target parameter ... and sets the second reward terms equal to the first reward terms....” *Id.* at column 11, lines 6-10.

Walker states, “[t]his is intended to **reduce the target** to enable to cardholder to achieve it.” *Id.* at column 11, lines 11-12 (emphasis added).

Assuming *arguendo* that the frequent flyer miles are equivalent to Applicants’ reward points as the Office Action asserts, a position traversed by Applicants, Walker still does not teach or suggest “determining an amount of reward points to associate with the financial account based on the reward incentive parameter and the received payment amount,” “associating the determined amount of reward points with the financial account,” and “wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a payment due date,” as recited in Applicants’ amended claims 1 and 21. Similarly, Walker does not teach or suggest “means for determining an amount of reward points to associate with the financial account based on the reward incentive parameter and the received payment amount,” “means for associating the determined amount of reward points with the financial account,” and “wherein the means for determining the amount of reward points includes means for reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a payment due date,” as recited in Applicants’ amended claim 11.

Similarly, although the Examiner asserts that “Walker et al. discloses that the reward incentives may comprises numerous reward types such as frequent flyer points,” Walker does not teach or suggest a first amount of reward points, a second amount of

reward points, or a third amount of reward points,” as recited in newly added claim 31. Office Action, page 16. Nor does Walker teach or suggest “determining a second amount of reward points to associate with the financial account based on the reward incentive parameter and the received payment amount,” “determining a third amount of reward points based on at least one of the received payment amount or the date of the received payment,” and “modifying the second amount of reward points based on the third amount of reward points,” as further recited in Applicants’ claim 31.

Since Walker fails to disclose each and every element of amended claims 1, 11, and 21, Applicants request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b). Furthermore, Applicants respectfully request allowance of independent claim 1, 11, 21, and 31, and their respective dependent claims 2-3, 7, 9-13, 17, 19-20, 27-30, and 32-36.

III. Claim Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 4-6, 14-16 and 24-26 under 35 U.S.C. § 103(a) as unpatentable over Walker because the Examiner has not established a *prima facie* case of obviousness as required under 35 U.S.C. § 103(a).

“To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

The Office Action asserts that “Walker discloses ... wherein determining an amount of reward points further comprises: reducing the amount of reward points based on a determination that the customer came close to achieving their designated performance value.” Office Action, page 9-11 and 13.

However, neither Walker, nor any obvious variant thereof, overcomes the deficiencies set forth above and the failure of Walker to teach or suggest “determining an amount of reward points to associate with the financial account based on the reward incentive parameter and the received payment amount,” “associating the determined amount of reward points with the financial account,” and “wherein determining the amount of reward points includes reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a payment due date,” as recited in Applicants’ amended claims 1 and 21. Similarly, Walker does not teach or suggest “means for determining an amount of reward points to associate with the financial account based on the reward incentive parameter and the received payment amount,” “means for associating the determined amount of reward points with the financial account,” and “wherein the means for determining the amount of reward points includes means for reducing the determined amount of reward points based on a determination that at least one of the received payment amount is below a minimum payment amount or the received payment was received after a payment due date,” as recited in Applicants’ amended claim 11. Indeed, during the interview, the Examiner acknowledged that Walker does not teach or suggest these features.

For at least these reasons, Applicants submit that neither Walker, nor any obvious variant thereof, teaches or suggests all the elements of Applicants' claims 4-6, 14-16 and 24-26. Thus, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103(a) and allowance of claim 4-6, 14-16 and 24-26.

IV. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Therefore, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims 1, 5-11, 15-21, and 25-36.


If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicants' representative at 202-408-4263.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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By: 
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